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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/237,176	08/29/88	VOGEL	

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EXAMINER	
GREGORY, E.	
ART UNIT	PAPER NUMBER
	3

DATE MAILED: 07/20/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-28 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-28 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

The disclosure is objected to because of the following informalities: spellings throughout the disclosure do not conform to American English. Appropriate correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "selector means" must be shown or the feature cancelled from the claim. No new matter should be entered.

The drawings show item number 6 of Figure 1 as the "means for comparing", but a "selector means" as claimed is not shown in the drawings.

Claims 27-28 are rejected for obviously failing to particularly point out and distinctly claim the invention as required by 35 U.S.C. 112, second paragraph.

Claims 1-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Method claims 1-13 and apparatus claims 14-26 are misdescriptive of the disclosed invention in that no "selector means" is disclosed to correspond to the claimed "selector means" or to implement the step of selecting. Item 6 of Figure 1 is "means for comparing", but there is no "selector means". Claims 1-26 are unclear in that they seem to say that the alternative is always selected, which is nonsensical. If the alternative is always selected, then no true selection has been made. Further, claims 1-26 are unclear and confusing in that the selection is claimed as made "according to the result of said comparison.". If there are only two alternatives (the program selected

and an alternative), how can an alternative be selected according to the result of said comparison?

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to teach adequately how to make and to use the invention.

There is no disclosure of "selector means" to support claim of "selector means" or claim of the method step of selecting.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 4-7, 9, 11, 13, 17-20, 22, 24, and 26 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112 and to include all of the limitations of the base claim and any intervening claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> "A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

Claims 1, 2, 10, 12, 14, 15, 23, and 25 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Von Kohorn ('404).

Von Kohorn ('404) addresses the problem solved by Applicant's invention at column 1, lines 45-60 and at column 2, lines 50-68. Please, also, note the transmission of control signals in Von Kohorn ('404) may be by radio link or via the audio portion of the transmitted program (column 2, lines 41-50). At column 7, lines 50-57 of Von Kohorn ('404), it is pointed out how Von Kohorn switches from the transmitted program selection to the alternate transmission of editorial messages. Von Kohorn ('404) can be used for editing a video recording or in direct viewing of programs (column 8, lines 22-26). Also, note that the monitoring equipment can be located at the transmitter itself (column 8, lines 49-63).

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Claims 3 and 16 are rejected under 35 U.S.C. 103 as being unpatentable over Von Kohorn ('404) in view of Amano et al ('229).

Von Kohorn ('404) differs from the further limitations of dependent claims 3 and 16 in not locating the alternate video source at the receiving station. It would have been obvious to one of ordinary skill-in-the-art that the alternate video could be locally generated as taught by Amano et al ('229) at column 1, line 53 through column 2 line 8 for numerous advantages such as: blocking all unsupervised viewing of programs for children save those images permitted as mentioned by Amano. Amano mentions an alternate image of the internal clock at the receiver. Von Kohorn ('404) differs from the further limitations of dependent claims 8 and 21 in transmitting control coding in the video.

Claims 8 and 21 are rejected under 35 U.S.C. 103 as being unpatentable over Von Kohorn ('404) in view of Horne ('131).

It would have been obvious to one of ordinary skill-in-the-art that coding could be transmitted, as is well-known in the art, in the horizontal blanking intervals as taught by Horne ('131) at column 7, lines 3-17. Transmission in the video has numerous advantages, among which is the greater data-carrying capacity of the higher video frequencies as opposed to audio.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Von Kohorn ('973); Cogswell et al ('974); Perine et al ('883); Kirk, Jr. ('457); Novak ('213); Hayes ('107); McVoy ('008); and, Moon et al ('479) show video editing systems similar to Applicant's invention.

Any inquiry concerning this communication should be directed to Bernarr Gregory at telephone number (703)-557-1976.

Stephen C Buczinski

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GROUP ART UNIT 222